

PATENTS ACT 1977

IN THE MATTER OF a reference under section 8(1)(a) by Stuart Millward in respect of Patent Application No. GB 9709101.1 in the name of Playaway Play Systems Limited

DECISION

1. Application 9709101.1 was filed on 7 May 1997 in the name of Playaway Play Systems Ltd, (hereinafter “Playaway”) naming Stuart Millward as inventor. It was filed without professional assistance and refers to Playaway’s Liverpool address as the address for service. From the evidence it is not disputed that it was Stuart Millward who had prepared and filed the application. The abstract of the invention succinctly defines it as an inflatable play unit of the type known as a “bouncy castle” characterised in that the inflating device is removably mounted in a pocket within the structure of the play unit.
2. The application was published on 11 November 1998 as GB 2324973 and granted on 24 March 1999. By virtue of section 9 of the Act which deals with the determination after grant of questions referred before grant this reference under section 8 concerning who is entitled to the patent is therefore treated as being made under section 37.
3. Stuart Millward filed a Form 2/77 and a statement on 2 October 1998 in which, in essence, he claimed to be independent of Playaway at the relevant date when the invention was put into practice so that not only was he entitled to be named as inventor of the play unit but also as the sole proprietor of the patent application.
4. A counterstatement on behalf of Playaway was filed on 7 December 1998 seeking the complete dismissal of Stuart Millward’s application or in the alternative that he should be named as a joint applicant. Thereafter the evidence rounds proceeded more or less harmoniously with only the usual arguments about extensions of time and a request by Stuart Millward to file further evidence-in-reply which was subsequently granted.

5. In summary the evidence comprises:-

a) For the referrer:-

A first affidavit plus exhibits A and B to prove that up to early May 1997 he was working independently as a consultant and was not employed by Playaway;

A second affidavit plus exhibit C which purports to be a crude sketch of the invention written on the back of a pamphlet published by the Royal Society for the Prevention of Accidents (RoSPA), exhibit D showing that since leaving Playaway he has been using the system of the invention in the products of his own firm, exhibit E which is a copy of his army commission and exhibit F showing his success at a Business Management course on leaving the army;

A third affidavit plus exhibit G which is a certificate of Trade Proficiency and exhibit H a City & Guilds certificate, both of these being submitted to prove his competence in devising and putting the invention into practice.

b) For the proprietor:-

A statutory declaration by Martin Millward, the referrer's brother;

A statutory declaration by Jane Harwood, the managing director of Playaway together with 6 exhibits JH1 to JH6. JH1 is in the form of the documents filed at the Patent Office at the time of making the patent application. JH2 shows the letters which passed between the Office and Playaway during the examination process. JH3 is a letter from the Referrer on Playaway's headed notepaper to Bounceabout Leisure Limited and together with documents JH4, JH5 and JH6 are intended to prove that Stuart Millward had accepted the proprietorship of Playaway of which he was an important member of the team.

6. On the evidence the following would appear to be undisputed:-

(a) The managing director of Playaway is Jane Harwood who established the company by way of its predecessor in 1990;

(b) In 1995 Jane Harwood employed Martin Millward, a skilled mechanical installation

engineer. Before this time he had assisted her on a casual basis. They are now married. Martin Millward was employed as a qualified and experienced engineer to look after the design, manufacture, testing and installation of products;

(c) Stuart Millward became a full-time employee of Playaway with effect from 5 May 1997 (2 days before the filing of the patent application) with a role as Operations Manager on the administrative side of the business. Prior to this time he had been used as a consultant by Playaway and when the arrangement showed that it was working well he was invited to become an employee. No written agreement between the parties seems to have been entered into at any time.

7. The matter of the proprietorship of the patent subsequently came before me at a hearing held on 14 October 1999 at which Stuart Millward represented himself and Playaway Play Systems Limited was represented by Mr Nicholas Manley of patent agents W P Thompson & Co. I understood at the hearing that the issue of the technical competency of both parties to devise the invention which had been one of the features of the written evidence was not being pursued. Thus, the significant argument was more to do with the history of events and the role of the three main players in relation to Playaway and this was indeed the way that the hearing proceeded

8. Stuart Millward's case, as in the written evidence, was relatively simple. It was that whilst acting as an independent consultant to Playaway he had the idea of locating the inflation device of a "bouncy castle" within the structure of the unit itself rather than using an external device which was conventional and associated with safety problems. This idea came to him one day during his drive to Playaway's premises in Liverpool and so he roughly sketched it out on the back of the RoSPA pamphlet and showed it to Martin Millward and Jane Harwood when he arrived. In his view the sketch showed the location of the blower in the unit and corresponds with the patent application as filed as well as with the products produced by his own company.

9. On that version of events Stuart Millward had taken the view that he had always had rights to the invention. This was a view that he maintained under cross-examination by Mr Manley. He thought that the inventor owned everything and the fact that he filed the patent application in the name of Playaway was put down to his inexperience of the patenting process. He claimed that through his inexperience he had believed that an individual (as opposed to a company) could not apply for a patent.

10. Mr Manley for Playaway addressed the matter of the ownership of the patent by reference to three general and independent points. Firstly, contrary to what was said on the Form 7/77, the inventor of the subject matter of the patent was Martin Millward and not Stuart Millward. Secondly, it was always understood by Martin Millward, Jane Harwood and Stuart Millward that the rights in the invention belonged to Playaway and that the patent application should be filed in the name of Playaway and thirdly, irrespective of these issues the evidence was insufficient for me to find in favour of Stuart Millward.

11. On the first point, Mr Manley's version of the events leading to the invention was that the idea of the concealment of an inflation fan had been considered for some time and that in March/April 1997 there had been discussions about this between Martin Millward and Stuart Millward. When questioned by me because of the statement by Martin Millward in paragraph 9 of his statutory declaration that Stuart Millward first had the idea of locating an inflation fan in the interior of the unit, Mr Manley said that Stuart Millward had given the aim but he was not the inventor of the actual invention. It was also Mr Manley's case that Stuart Millward's reliance on the sketch on the back of the RoSPA pamphlet to support his version of the events was ill-founded but I shall come to that later in considering his third point.

12. In addressing the second point Mr Manley referred to a period in early 1997 when it seemed that the relationship between Stuart Millward on the one hand and Martin Millward and Jane Harwood on the other was relatively harmonious. Playaway seemed to be expanding and Stuart Millward had been taken on firstly as a consultant and then as full-time employee to help advance the business. According to Mr Manley it had been agreed amongst all three that a patent application should be filed with the rights in the invention belonging to Playaway. In his opinion if Stuart Millward had any rights at all they had been assigned effectively to Playaway although he admitted that there were no written contracts. Moreover, he submitted that the subsequent proceedings with respect to the patent application were consistent with the invention belonging to Playaway not least because letters to the Patent Office, prepared and signed by Stuart Millward, were written on Playaway's headed notepaper and at least in one letter dated 9 September 1997 referred to his pleasure "in submitting our company's patent claims amendments".

13. When questioned by Mr Manley under cross-examination Stuart Millward explained his actions with respect to the filing of the patent application in terms of his inexperience with the

patent procedure. He was of the opinion at the time that an inventor owned everything but that an individual could not own a patent. This was the basis for his actions in corresponding with the Patent Office on Playaway's headed notepaper and for filling in the various sections of Form 1/77, the application for the grant of a patent, as he had. Overall his argument seemed to be that the way he had proceeded with the patent application, including how he filled in the various forms, did not convey to him that he was signing over any rights he may have had.

14. Unfortunately the relationship deteriorated from about October 1997 onwards and had completely broken down by May 1998 whereafter Stuart Millward took the steps leading to this application to transfer the rights in the invention. It seems that only when the relationship began to break down did Martin Millward and Jane Harwood have any idea of what was in the patent application having previously allowed Stuart Millward to get on with the job without oversight.

15. On the third point Mr Manley made much of the fact that there was very little evidence put into the case by Stuart Millward and, of that, great reliance was being put on the sketch made on the back of the RoSPA pamphlet. In his view this did not help Stuart Millward's case because there was no evidence that the latter had drawn it, or when he had drawn it or that he had disclosed it to anyone at Playaway. In this lattermost respect, both Jane Harwood and Martin Millward deny having ever seen it. Moreover, in his statement at paragraph 4 Stuart Millward had said that he had designed the original concept illustrations using his own company's computing equipment and other resources. There was though, said Mr Manley, no evidence to support this contention.

16. When pressed on this point under cross-examination Stuart Millward appeared to be saying that the evidence in effect was that there was an obvious natural progression in moving from the sketch to computer designed drawings which then formed the basis of the patent application.

17. These then are the arguments advanced by both parties as to why their respective versions of events should be regarded as true in the devising of the invention but before coming to my decision I want to make some brief points about the conduct of the case. It is unfortunately the case that Stuart Millward's statement, affidavits and supporting evidence are remarkably brief, no doubt arising from the fact that he has prosecuted this case without a great deal of professional help. This brevity placed a severe restriction on him at the hearing since there was

little scope for him to develop his argument without introducing evidence which was not apparent from the papers. However, I must say that under cross-examination he acquitted himself well, did not weaken his argument in any way and came across with a strong conviction about his case. Had he been professionally represented throughout the proceedings or had he chosen to cross-examine Jane Harwood and Martin Millward then it is very likely that he could have made more of his case.

18. Ultimately, it is the brevity of Stuart Millward's case plus the lack of proof to sustain much of his argument that leads me to conclude that I cannot find in his favour.

19. As Mr Manley said at the hearing when the evidence about Stuart Millward's qualifications is stripped away there are only unsupported statements about how the invention came into being. Most of these statements are in respect of the sketch drawn on the back of the RoSPA pamphlet and I have to say that in view of the basic nature of that sketch and the absence of proof of a date for when it was drawn it does not help Stuart Millward's case at all. Had he been able to produce in evidence dated concept illustrations prepared on his company's computing equipment as he described in the fourth paragraph of his statement then no doubt his case would have been stronger. At the end of the day the onus is firmly on Stuart Millward to prove his version of the events leading to the invention and this he has failed to do.

20. When it comes to considering the evidence about the initiation and prosecution of the patent application before the Patent Office I can well understand the doubts he may have had about filling in correctly the required forms. Many people when faced with official forms for the first time find it a daunting task to provide the correct information but Patent Office forms 1/77 and 7/77 are not, in my view, difficult forms to understand. Having had an opportunity to look at how Stuart Millward filled in these forms there is a consistency which does not suggest to me that he had great difficulty. Given the passion with which he presented his argument at the hearing I can only say that it is a pity that apparently he did not spend more time thinking about the consequences of what he was writing down.

21. If I take Form 7/77 as an example, at section 3 the applicant is clearly defined by Stuart Millward as Playaway Play Systems. Section 5 of the same form requests that it be stated as to how the applicant derived the right from the inventor to be granted a patent and Stuart Millward has filled in the words "Inventor in company's employment at the time of the invention". Whilst

I accept that he may have been inexperienced in filling in the forms required by the Patent Office I do find it difficult to believe that as he filled in this particular section he was giving no thought to who would own the rights in the patent. The subsequent prosecution of the application before the Patent Office using Playaway's headed notepaper and the use of such terms as "our company" is moreover entirely consistent with the picture not being quite as simple as he has painted it.

22. Whatever is the true story Stuart Millward has not been able to discharge the onus on him to satisfy me that he is entitled to be named as proprietor of the patent rather than Playaway Play Systems Limited. I therefore confirm that I have found against him and dismiss his application.

23. Although costs were not mentioned at the hearing I note from the counterstatement that the opponent's have requested them. Costs in proceedings before the Patent Office are not intended to compensate parties for the expense to which they have been put and therefore after consulting the standard scale of costs presently in existence I order that Stuart Millward should pay to Playaway Play Systems Limited the sum of £635.

24. This being a decision on a substantive matter, the period for appeal set under The Civil Procedure Rules 1998 is six weeks.

Dated this 9th day of November 1999

G M BRIDGES

Divisional Director, acting for the Comptroller

THE PATENT OFFICE